

REMARKS

Applicants note that all amendments, cancellations, and additions of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the cancelled claims (or similar claims) in the future.

In the office action dated 9/11/03, the Examiner made a number of rejections. The rejections are listed below in the order in which they are herein addressed.

- (1) Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite;
- (2) Claims 1, 9-12, 25, 27, 29, 32-33 and 37 are rejected under U.S.C. 102 (b) as allegedly being anticipated by Pierce et al (WO 97/49434; hereinafter Pierce);
- (3) Claims 25, 27 and 29-30 are rejected under U.S.C. 102 (b) as allegedly being anticipated by Wagner et al (Proc. Natl. Acad. Sci. 87:3410 [1990]; hereinafter Wagner);
- (4) Claims 25-32 are rejected under U.S.C. 102 (b) as allegedly being anticipated by Ferkol, Jr. et al (U.S. Patent No. 5,972,900; hereinafter Ferkol);
- (5) Claims 25-27, 29-23 and 32 are rejected under U.S.C. 102 (b) as allegedly being anticipated by Chroboczek et al (WO 97/18317; hereinafter Chroboczek);
- (6) Claims 38-42 are rejected under U.S.C. 103 (a) as allegedly being obvious in light of Chroboczek in view of Cheng (U.S. Patent 6,077,834; hereinafter Cheng); and

¹ 65 Fed. Reg. 54603 (Sept., 8, 2000).

(7) Claims 1-13, 25-33 and 37 are rejected under 35 U.S.C. 101 as allegedly claiming the same invention as copending application serial number 09/960,454.

I. The Claims are not Indefinite

The Examiner has rejected Claim 28 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite (Office Action, pg. 5). The Examiner has rejected Claim 28 as not providing proper antecedent basis for the claim term "wherein the membrane permeable molecule is a cationic lipid." (Office Action, pg. 5). The applicants have amended Claim 28 to depend on Claim 25, which provides antecedent basis for the term "membrane permeable molecule." As such, the rejection is moot.

II. The Claims are Novel

In the Office Action dated 9/11/03, the Examiner rejected the claims as allegedly being anticipated by a number of references. The applicants respectfully disagree and submit that the claims are novel. Each of the rejections is addressed below.

A. The Claims are not Anticipated by Pierce

The Examiner has rejected Claims 1, 9-12, 25, 27, 29, 32-33 and 37 under U.S.C. 102 (b) as allegedly being anticipated by Pierce (Office Action, pg. 5). The Applicants respectfully disagree and submit that the claims are novel as written. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have cancelled claims 11-12 and amended independent claims 1, 25, and 37. The amended claims include the claim element of a third complexing agent comprising a membrane permeable molecule. As Pierce does not teach such an agent, the Applicants respectfully request that the rejection be withdrawn.

B. The Claims are not anticipated by Wagner

The Examiner has rejected Claims 25, 27 and 29-30 under U.S.C. 102 (b) as allegedly being anticipated by Wagner (Office Action, pg. 6). The Applicants respectfully disagree and submit that the claims are novel as written. Nonetheless, as described above, the Applicants

have amended Claim 25 to include the claim element of a third complexing agent comprising a membrane permeable molecule. As Wagner does not teach such an agent, the Applicants respectfully request that the rejection be withdrawn.

C. The claims are not anticipated by Ferkol

The Examiner has rejected Claims 25-32 under U.S.C. 102 (b) as allegedly being anticipated by Ferkol (Office Action, pg. 7). The Applicants respectfully disagree and submit that the claims are novel as written. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended claim 25 to include the claim element of a transfection complex attached to a solid surface. As Ferkol does not teach a transfection complex attached to solid surface, the Applicants respectfully request that the rejection be withdrawn.

D. The Claims are not anticipated by Chroboczek

The Examiner has rejected Claims 25-27, 29-20 and 32 under U.S.C. 102 (b) as allegedly being anticipated by Chroboczek (Office Action, pg. 8). The Applicants respectfully disagree and submit that the claims are novel as written. As described above, the Applicants have amended Claim 25 to include the claim element of a transfection complex attached to a solid surface. As Chroboczek does not teach a transfection complex attached to a solid surface, the applicants respectfully request that the rejection be withdrawn.

III. The Claims are Non-Obvious

The Examiner has rejected Claims 38-42 under U.S.C. 103 (a) as allegedly being obvious in light of Chroboczek in view of Cheng. The applicants respectfully disagree. The Applicants submit that the examiner has failed to provide a *prima facie* case of obviousness. The combination of references referred to by the Examiner fails to provide a *prima facie* showing of obviousness as required by § 2143 of the Manual of Patent Examining Procedure (MPEP). There are three criteria which must be met to provide *prima facie* obviousness. The first of these criteria is a suggestion or motivation in the references or the knowledge generally available to combine the reference teachings. The second criteria is that the prior art must teach or suggest

all the claim limitations. The third criteria is a reasonable expectation of success should the combination be carried out.

Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness because none of the three criteria have been met. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended claim 38 to include the element of a transfection complex attached to a solid support. As neither Chroboczek or Cheng, alone or in combination, teach or suggest the claim element of a transfection complex attached to a solid support, the applicants respectfully request that the rejection be withdrawn.

IV. The Claims are not subject to Double Patenting

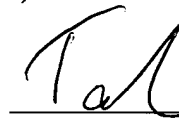
Claims 1-13, 25-33 and 37 are rejected under 35 U.S.C. 101 as allegedly claiming the same invention as copending application serial number 09/960,454. The applicants respectfully disagree. Claims 1-13, 25-33 and 37 have been withdrawn from application serial number 09/960,454 due to a restriction and/or election requirement. As such, the rejection is moot.

The applicants further submit that claims 3-8 and 13 are not subject to any rejections. Accordingly, the applicants request that Claims 3-8 and 13 be passed to allowance.

CONCLUSION

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call the undersigned collect at (618) 218-6900.

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